

I. REMARKS

By way of summary, Claims 10-11, 36, 41-42, 44-45, 47-49, 56-57, and 59-68 are pending prior to entry of this amendment. By this paper, Claims 10, 36, 56, and 63 are amended and Claims 41, 47, 59, and 65 are canceled. Thus, Claims 10-11, 36, 42, 44-45, 48-49, 46-57, 60-64, and 66-68 are presently pending and presented for consideration.

Claims 10, 11, 41-42, 44-45, and 63-68 are rejected under 35 U.S.C. § 101 for being directed towards non-statutory subject matter. Claims 10, 11, 36, 41, 42, 44, 45, 47-49, 56, 47-49, 56, 57, and 59-68 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,279,112 to O'Toole Jr., et al. ("O'Toole") in view of U.S. Patent No. 6,304,857 to Heindel, et al. ("Heindel"), and further in view of U.S. Patent No. 5,659,742 to Beattie, et al. ("Beattie"), and further in view of U.S. Patent No. 6,148,142 to Anderson ("Anderson"). In view of the following remarks, the Applicants respectfully request reconsideration and allowance of the claims.

A. Claims 10, 11, 41-42, 44-45, and 63-68 Comply with 35 U.S.C. § 101

By this paper, Claim 10 has been amended to recite, in part, "transforming, by a computing device, the one or more selected content data objects from respective native formats as provided by the respective publishers to a device-specific format associated with a type of the client device." Claim 63 is amended to recite, in part, "at least one processor configured to execute software modules including at least:" and "means for transforming one or more of the selected content data objects from respective native formats as provided by the publishers to another format, different than the native formats, based upon the client device type."

The Applicants respectfully submit that amended Claims 10 and 63 recite the statutory classes to which the method operations are tied. In particular, each of Claims 10 and 63 recites operations that are performed by "a computing device." Claims 10 and 63 further recite processes in which the underlying subject matter is transformed to a different state. Therefore each of Claims 10 and 63 satisfies the requirements of 35 U.S.C. § 101. Claims 11, 41-42, 44-45, and 64-68 depend either directly or indirectly from Claims 10 and 63 and also recite the statutory classes to which the method

operations are tied and processes in which the underlying subject matter is transformed to a different state. Withdrawal of the rejection of Claims 10, 11, 41-42, 44-45, and 63-68 under 35 U.S.C. § 101 is therefore respectfully requested.

B. Claims 10, 11, 36, 42, 45, 48-49, 56, 57, 60-64 and 66-68 Are Not Obvious In View of O'Toole, Heindel, Beattie, and Anderson

Claims 10, 11, 36, and 41, 42, 44, 45, 47-49, 56, 57, and 59-68 are rejected under 35 U.S.C. §103(a) as being unpatentable over O'Toole, Heindel, Beattie, and Anderson. The Applicants respectfully submit that Claims 10, 11, 36, 42, 45, 48-49, 56, 57, 60-64 and 66-68 are patentably distinct from O'Toole, alone and in combination with any of Heindel, Beattie, and Anderson.

Pursuant to M.P.E.P. § 2141:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that '[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.' *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396.

Further pursuant to M.P.E.P. § 2143(A), "Combining Prior Art Elements According to Known Methods To Yield Predictable Results" (emphasis added):

To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Then, Office personnel must articulate the following:

- (1) **a finding that the prior art included each element claimed**, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;
- (2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately;
- (3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and

(4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. KSR, 550 U.S. at ___, 82 USPQ2d at 1395; Sakraida v. AG Pro, Inc., 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); Anderson's-Black Rock, Inc. v. Pavement Salvage Co., 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." KSR, 550 U.S. at ___, 82 USPQ2d at 1396. If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

a. Independent Claim 10

Amended Claim 10 recites, in part, "transforming, by a computing device, the one or more selected content data objects from respective native formats as provided by the respective publishers to a device-specific format associated with a type of the client device"

The Office Action acknowledges (Page 6, Item 9), that O'Toole fails to disclose "transforming the one or more of the selected content data objects from respective native formats as provided by the respective publishers to the requested format." The Office Action further states:

Anderson ('142) discloses transforming the one or more of the selected content data objects from respective native formats as provided by the respective publishers to the requested format; ... It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the O'Toole Jr. et al. (US Patent 6,279,112) in view of Heindel et al. (US Patent 6,304,857) and further in view of Beattie et al (US Patent 5,659,742) with Anderson ('142) method in order to allow storage of media in a standardized format.

The Applicants respectfully disagree with the characterization of the Anderson reference and submit that the combination of O'Toole, Heindel, Beattie, and Anderson fails to teach or suggest each and every feature of amended Claim 10 and, therefore, the rejection of Claim 10 in view of the combination of O'Toole, Heindel, Beattie, and Anderson cannot be supported.

Anderson discloses:

The download PC 48, in addition to processing movie requests from the users 44, is used to ***convert movies received via a downlink 50 from a source provider in analog form into compressed video and audio digital form***. The preferred compression format is Motion Picture Experts Group (MPEG), although other compression formats can be used. (Anderson, Col 3, Lines 44-51)

From the forgoing, it may be understood that Anderson discloses a PC 48 which "convert[s] movies received via a downlink 50 from a source provider in analog form into compressed video and audio digital form." In contrast, Claim 10 recites, in part, "transforming, by a computing device, the one or more selected content data objects from respective native formats by the respective publishers to a ***device-specific format associated with a type of the client device***" Conversion of movies into compressed video and audio form, as described by Anderson, is very different from the transformation recited in Claim 10, as the conversion of Anderson is performed independently of the client device that receives the movie. In contrast, Claim 10 recites a transformation "from respective native formats by the respective publishers to a device-specific format associated with a type of the client device."

As discussed above, the Office Action acknowledges that this deficiency is not remedied by O'Toole. Heindel and Beattie fail to remedy this deficiency. For at least these reasons, the combination of O'Toole, Heindel, Beattie, and Anderson fails to teach or suggest each and every element of Claim 10. Therefore, the Applicants respectfully submits that the conclusion that Claim 10 would have been obvious in view of the combination of O'Toole, Heindel, Beattie, and Anderson cannot be supported, and that Claim 10 is allowable over the combination of O'Toole, Heindel, Beattie, and Anderson.

b. Independent Claim 36

Independent Claim 36 recites:

A computer in data communication with a client device via one or more networks, the computer comprising:

a processor; and

a computer readable storage device configured to store one or more programs;

wherein the computer is configured to execute one or more programs stored on the computer readable medium in order to

initiate transmission of a first interface to a client device, the first interface configured to receive selections of one or more content data objects associated with respective content publishers;

initiate transmission of a second interface to the client device, the second interface configured to receive selections of payment terms for transmission of the selected content data objects;

determine a client format based on at least a type of the client device;

transform one or more of the content data objects from respective native formats to the client format, different than at least some of the respective native formats; and

initiate transfer of portions of a payment from a payment account to publishers of the selected content data objects in accordance to respective contributed proportions of the aggregated content data objects.

For at least the reasons discussed above, where applicable, the proposed O'Toole, Heindel, Beattie, and Anderson combination fails to disclose or suggest each and every element of Claim 36. Therefore, withdrawal of the rejection of Claim 36 under this combination is respectfully requested.

c. Independent Claim 56

Independent Claim 56 recites:

A computer readable storage medium having instructions stored thereon that, in response to execution by a computing device, cause the computing device to perform operations comprising:

receiving content data objects from one or more computing devices;

receiving a selection of some of the content data objects;

receiving payment terms and conditions;

initiating transfer of portions of a payment from a payment account associated with a client device to one or more publishers of the selected content data objects;

determining a client format based on at least a type of the client device; and

transforming one or more of the selected content data objects from respective native formats to the determined client format.

For at least the reasons discussed above, where applicable, the proposed O'Toole, Heindel, Beattie, and Anderson combination fails to disclose or suggest each and every element of Claim 56. Therefore, withdrawal of the rejection of Claim 56 under this combination is respectfully requested.

d. Independent Claim 63

Independent Claim 63 recites:

A computing device comprising:

at least one processor configured to execute software modules including at least:

a publication module configured to receive content data objects from a plurality of publishers;

a content selection module configured to receive selections of two or more of the content data objects; and

means for transforming one or more of the selected content data objects from respective native formats as provided by the publishers to another format, different than the native formats, based upon the client device type.

For at least the reasons discussed above, where applicable, the proposed O'Toole, Heindel, Beattie, and Anderson combination fails to disclose or suggest each and every element of Claim 63. Therefore, withdrawal of the rejection of Claim 63 under this combination is respectfully requested.

C. Dependent Claims

Claims 11, 42, 44-45, and 62 depend from Claim 10 and, therefore, include each of the limitations of Claim 10. Claims 48-49, and 68 depend from Claim 36 and, therefore, include each of the limitations of Claim 36. Claims 57, 60-61, and 67, depend from Claim 56 and, therefore, include each of the limitations of Claim 56. Claims 64 and 66 depend from Claim 63 and, therefore, include each of the limitations

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of Claim 63. Claims 11, 42, 44-45, 48-49, 57, 60-62, 64, 66-68 are believed to be allowable over the cited art for at least the reasons discussed above with respect to their respective base claims, as well as their individual patentable features.

Applications of Assignee

The Applicants wish to draw the Examiner's attention to the following applications of the present application's assignee.

Docket No.	Serial No.	Title	Filed
KM2158.001A	09/896,017 Now U.S. Patent No. 7,155,477	METHOD AND SYSTEM FOR CONTINUOUS INTERACTIVE COMMUNICATION IN AN ELECTRONIC NETWORK	06/28/01

The Applicants note that cited references, office actions, responses, and notices of allowance currently exist or will exist for the above-referenced matter. The Applicants also understand that the Examiner has access to sophisticated online Patent Office computing systems that provide ready access to, for example, specification and drawing publications, pending claims and complete file histories, including, for example, cited art, office actions, responses, and notices of allowance. However, if the Examiner cannot readily access these file histories, the Applicants would be pleased to provide any portion of any of the file histories at any time upon specific Examiner request.

II. SUMMARY

Certain features of pending independent claims have been discussed above. However, the discussed features are only a limited representation of the features that are believed to be patentable over the cited art. Furthermore, because a rejection under 35 U.S.C. § 102 requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," and a rejection under 35 U.S.C. §103 similarly requires that the references when combined teach or suggest all of the claim limitations, the Applicants further assert that the combinations of features in each claim are patentable over the cited art. *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, (Fed. Cir. 1987); *M.P.E.P.* § 2143.

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The Applicants have endeavored to address all of the Examiner's concerns as expressed in the Office Action. Accordingly, amendments to the claims, the reasons therefore, and arguments in support of patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are made in order to improve the clarity of claim language, to correct grammatical mistakes or ambiguities, and/or to otherwise improve the clarity of the claims to particularly and distinctly point out the invention to those of skill in the art. Finally, the Applicants submit that the claim limitations above represent only illustrative distinctions. Hence, there may be other patentable features that distinguish the claimed invention from the prior art.

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, the Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. The Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that the Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

In view of the foregoing, the Applicants respectfully request reconsideration and withdrawal of the outstanding rejections and, particularly, that all claims be allowed. If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully invited to call the undersigned.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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